



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/849,239	05/07/2001	Walter R. McVey	9046-0050	8042

26171 7590 10/05/2004

FISH & RICHARDSON P.C.  
1425 K STREET, N.W.  
11TH FLOOR  
WASHINGTON, DC 20005-3500

EXAMINER
----------

CHOI, LING SIU

ART UNIT	PAPER NUMBER
----------	--------------

1713

DATE MAILED: 10/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

<b>Office Action Summary</b>	<b>Application No.</b> 09/849,239	<b>Applicant(s)</b> MCVEY ET AL.	
	<b>Examiner</b> Ling-Siu Choi	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) 15-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10/15/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a **method** to perform electrophoresis, classified in class 204, subclass 450.
  - II. Claims 15-16, drawn to a **method** to process electrophoresis data , classified in class 204, subclass 461.
  - III. Claims 17-18, drawn to an electrophoresis **apparatus**, classified in class 204, subclass 600.
  - IV. Claims 19-20, drawn to a **computer readable medium**, classssified in class 204, subclass 612.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and (II or IV) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to a **method** to perform electrophoresis, a **method** to process electrophoresis data, and a **computer readable medium**.

Inventions (II or IV) and III are unrelated. Inventions are unrelated if it can be

Art Unit: 1713

shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions relate to a **method** to process electrophoresis data and an electrophoresis **apparatus**.

Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as isoelectric focusing.

Inventions II and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by hand.

3. During a telephone conversation with Julius Fister III on August 3, 2004, a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Art Unit: 1713

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Objections***

5. Claim 1 is objected to because of the following informalities: (a) claim 1, line 5, change "reference fragments" to --the reference fragments--and (b) claim 1, line 10, change "sample and reference fragments" to --the sample fragments and the reference fragments--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

**A person shall be entitled to a patent unless --**

**(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.**

Art Unit: 1713

7. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Falkner et al. (US 5,789,153).

The present claims relates to a method to perform electrophoresis comprising

(a)	<b>providing</b> a plurality of sample fragments collectively having a first range of sizes, the sample fragments being tagged with a first number of dyes
(b)	<b>providing</b> a plurality of reference fragments collectively having a second range of sizes which does not overlap with the first range of sizes, the reference fragments being tagged with a common dye from among the first number of dyes
(c)	combining the sample fragments and the reference fragments into a common volume
(d)	causing the sample fragments and the reference fragments within the common volume to separate along a common separation lane such that the sample fragments and the reference fragments are separated from one another in at least one of time and space
(e)	optically detecting the separated sample and reference fragments
(f)	determining <b>first color calibration information</b> from spectral properties of detected <b>reference fragments</b>
(g)	employing the first color calibration information to <b>identify at least one property of the sample fragments</b>

(summary of claim 1)

Falkner et al. disclose a method to quantitate nucleic acids in a sample by (a) adding given amounts of at least two known nucleic acid molecules to the sample as an internal standard, the standard nucleic acid molecules differing from the nucleic acid in

Art Unit: 1713

the sample by at least one detectable characteristic, wherein at least two known nucleic acid molecules and the nucleic acid to be quantitated are amplified by the same primers, (b) carrying out the separation by means of a gel electrophoresis, (c) determining the amounts of the nucleic acid to be quantitated in the sample and the standard nucleic acid, and (d) determining the amount of the nucleic acid to be quantitated in the sample, wherein the primers contain fluorescent groups (abstract; col. 10, lines 18-25; claims 1 and 3). Thus, the present claims are anticipated by the disclosure of Falkner et al..

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ling-Siu Choi whose telephone number is 571-272-1098.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reach on 571-272-1114.

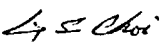
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 09/849,239

Page 7

Art Unit: 1713

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**LING-SUI CHOI**  
**PRIMARY EXAMINER**

Ling -Siu Choi, Ph.D.

September 27, 2004